



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,520	07/30/2003	Barry M. Verdegan	4191-00308	9250

26753 7590 03/09/2006

ANDRUS, SCEALES, STARKE & SAWALL, LLP  
100 EAST WISCONSIN AVENUE, SUITE 1100  
MILWAUKEE, WI 53202

EXAMINER

MATZEK, MATTHEW D

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/630,520	Applicant(s) VERDEGAN ET AL.	
	Examiner Matthew D. Matzek	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 99 and 102-104 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 99 and 102-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/2005 has been entered.
2. Claims 1-98, 100 and 101 stand canceled. Claims 99 and 102 are currently active. The rejections of the canceled claims have been withdrawn. The rejections in view of Till et al. (US 3,075,735) have been withdrawn as the reference only teaches the use of one type of fibers (i.e. rayon) and as such would not provide the instantly claimed different properties between the coarse and nanofibers. The rejection in view of Fischer et al. has been withdrawn as the reference failed to teach a difference in adsorptivity and wettability.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 99 and 102-104 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wilson et al. (US Patent 6,155,432) as substantially set forth in the Office Action dated 9/19/2005. Newly added claims do not provide any additional structural limitations and only address wettability properties of the coarse and nanofibers. Although Wilson et al. do not explicitly teach the claimed feature differing

Art Unit: 1771

adsorption and wettability properties, it is reasonable to presume that said properties are inherent to Wilson et al. Support for said presumption is found in the use of like materials (i.e. [ceramic, silica and alumina nanofibers and glass and ceramic coarse fibers]). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of differing adsorption and wettability properties would obviously have been present one the Wilson et al. product is provided.

***Response to Arguments***

4. Applicant's arguments filed 12/15/2005 have been fully considered but they are not persuasive.
5. Applicant argues that Examiner must provide evidence to substantiate the assertion that the claims are "rejected as the prior art meets the chemical and physical limitations set forth in the independent claim". With regards to the rejection of claims 99 and 102-104 in view of Wilson et al. (US Patent 6,155,432) said evidence has been provided by Applicant's own disclosure [0025] in which Applicant and Wilson et al. use the same materials to make the nano and coarse fibers. The structural limitations of the filter media have been addressed supra in the rejection. The instantly claimed properties may not have been addressed in the prior art, however as the prior art meets the claimed structural limitations and is made of the same composition as Applicant the instantly claimed properties are necessarily present in the article of the prior art.
6. Applicant has relied upon MPEP 2144.03 as a basis for argumentation in addressing the previously applied art rejections. This basis for argumentation has been noted but is irrelevant, as the Examiner has not relied upon "common knowledge" in the formation of the

Art Unit: 1771

previous/current art rejections. The Examiner has instead relied upon inherency. Applicant is advised to consider MPEP 2112 generally and 2112 (III), in particular. Although Wilson et al. do not explicitly teach the claimed features of adsorption and wettability, it is reasonable to presume that said properties are inherent to Wilson et al. Support for said presumption is found in the use of like materials (i.e. [ceramic, silica and alumina nanofibers and glass and ceramic coarse fibers]). Further support and evidence for said presumption has been provided by Applicant's own Specification, which teaches that the materials of the applied prior art, disclosed and used, exhibits the properties claimed. The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of adsorption and wettability would obviously have been present one the Wilson et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm

MDM



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700